

### **REMARKS**

Reconsideration of the present application is respectfully requested. Claims 1-18 have been rejected and are now pending. Claims 1-8 and 15-17 stand rejected under 35 U.S.C. § 101. Claims 1-18 stand rejected under 35 U.S.C. § 103(a). Arguments traversing the rejections are presented below. Claims 1, 9, 15-17, and 18 have been amended to overcome the respective rejections.

### **Summary of Telephonic Interview**

Applicant thanks the Examiner (Hung Q. Pham) for being available for, and participating in, a telephonic interview that occurred on July 13, 2007, in which Applicant's representatives discussed the differences between the claimed invention and the references cited in the Office Action to support the 35 U.S.C. § 103(a) rejection of claims 1-18. Specifically, Applicant's representatives brought to the attention of the Examiner that the inventive aspects of the present invention, including the two aspects of "automatically validating records against a predefined format" and a "feedback mechanism [that] offers assistive input and flags the errors" upon recognizing errors, are not taught by the Excel reference. The Examiner indicated that first, and possibly the second, aspect above, as amended to the claims, will help clarify the distinction between the claimed invention and the Excel reference.

### **Rejections based on 35 U.S.C. § 101**

Claims 1-8 stand rejected under 35 U.S.C. § 101 for being directed toward one or more tangible computer-readable media. In response, claim 1 has been amended, as presented hereinabove, to recite "computer-storage media." As such, the claim is not drawn to a form of

energy. It is respectfully submitted that, as amended, claim 1 is tangible media and is directed toward statutory subject matter. Further, claims 2-8 depend directly from independent claim 1 and, accordingly, are directed toward statutory subject matter for at least their dependency on claim 1.

Claims 15-17 stand rejected under 35 U.S.C. § 101 because they are alleged to be directed to software per se, *i.e.*, for being directed at non-statutory subject matter. In response, claims 15-17 have been amended as hereinabove set forth to recite “user interface component,” “first cable-label records module,” and “second cable-label records module.” Further claims 15-17 now recite “computer-storage media.” It is respectfully submitted that the limitations of claims 15-17, as amended herein, are directed toward components on tangible media; as such, these claims relate to a physical article, which is statutory material.

**Rejection based on 35 U.S.C. § 102(a)**

The office action states that Applicant’s argument with respect to 35 U.S.C. § 102, filed in response to the non-final office action dated 28-Dec-06, is moot considering the new grounds of rejection. However, there is no § 102 rejection asserted by the Examiner in the present final office action. As such, there is confusion as to whether the prior § 102 argument was persuasive in overcoming the § 102 rejection. It is respectfully requested, for clarity of the record, that the Examiner provide a response indicating that this prior § 102 argument was persuasive in overcoming the § 102 rejection of the non-final office action.

**Rejection based on 35 U.S.C. § 103(a)**

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable under Brady Worldwide (LabelMark Labeling Software) (hereinafter the “Brady reference”) in view of Applicant Admitted Prior Art and Microsoft Excel 2000 (hereinafter the “Excel reference”).

The Brady reference and the Excel reference, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 1-18. Applicant respectfully traverses this rejection, as hereinafter set forth.

Independent claims 1, 9, 15, and 18 recite, “automatically validating one or more records against a predefined format” or a variation thereof, as amended herein above. As stated in the Office Action, the Brady reference does not teach validating records. The Excel reference does not teach automatically validating records against a predefined format. Instead, the Excel reference teaches manually selecting an attribute that filters a user-selected range of values within a collection of data. The filtration may then be manually executed by a user. Therefore, the Excel reference does not automatically validate a record upon entry of the record, nor does the Excel reference validate the record against a predefined format configured within the computer system. As a result, it is respectfully submitted that the Excel reference fails to cure the deficiencies of the Brady reference.

Further, independent claims 1, 9, 15, and 18 recite “upon recognizing the errors, a feedback mechanism offers assistive input and flags the errors,” as amended hereinabove. As stated in the Office Action, the Brady reference does not teach a feedback mechanism. The Excel reference does not teach a feedback mechanism that (a) offers assistive input to help correct errors, or (b) flags the errors. Instead, the Excel reference teaches providing a general

alert in response to a single type of error, not multiple types of “errors.” The alert does not offer assistive feedback, but simply warns of an error. Further, the alert does not attach to data, or flag data, if uncorrected. Therefore, the Excel reference does not meet either of the limitations above, and as a result, it is respectfully submitted that the Excel reference fails to cure the deficiencies of the Brady reference. Accordingly, the proposed combination does not meet the limitations of the claimed subject matter, and as a matter of law the Examiner’s rejection cannot stand.

In view of the above, it is respectfully submitted that the Brady reference and the Excel reference, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 1, 9, 15, and 18. As such, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of these claims be withdrawn. Each of claims 1, 9, 15, and 18 is believed to be in condition for allowance and such favorable action is respectfully requested.

Further, claims 2-8, 10-14, 16, and 17 depend, either directly or indirectly, from the independent claims and are allowable based, in part, on their dependency thereon.

The Brady reference states that “LabelMark . . . allow[s] you to easily create labels *for* a variety of industrial applications” (emphasis added). This statement does not support the Examiner’s reading in the Office Action that “labels can be created *from* a variety of industrial applications” (emphasis added). The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is no teaching or suggestion in the Brady reference that indicates some consideration of creating and/or validating records at an external source and importing such records to another source having labeling software. Moreover, the Brady reference teaches away

from the interaction of multiple applications as evidenced by the statement, "Everything you need to produce a single label or multiple labels can be found from one starting screen fully equipped with a menu bar and toolbars containing icons for easy label editing and formatting." That is, the Brady reference suggests a single application to create, edit, and search records. Accordingly, there is no suggestion to combine the Excel reference to the Brady reference, but there is a suggestion to use the Brady reference as a stand-alone application.

The Excel reference relied upon by the Examiner is not in the Applicant's field of endeavor. A prerequisite to making a finding of obviousness is determining what is "prior art," in order to consider whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. This determination is frequently couched in terms of whether the art is analogous or not, *i.e.*, whether the art is "too remote to be treated as prior art." In re Sovish, 769 F.2d 738, 741, 266 USPQ 771, 773 (Fed. Cir. 1985). When regarding the field of endeavor, the present invention deals with receiving criteria to generate a cable-label record that is processed (*i.e.*, automatically validated, automatically identified, and utilized to generate a cable-label file). See *Application* at claims 1, 9, 15, and 18. In contrast, the Excel reference is directed toward manually manipulating data. The Excel reference is not directed toward nor does it teach a automatically processing records based on predetermined formats so as to reduce processing errors. Also, the Excel reference is not tailored to manipulating records that relate to cable labels, therefore, not applicable to the problem that the present invention is attempting to solve. Consequently, this reference relied upon by the Examiner is not in the field of the inventor's endeavor and should not be relied upon for the basis of an obviousness rejection.

### **CONCLUSION**

For at least the reasons stated above, claims 1-18 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned at 816-474-6550 or btabor@shb.com (such communication via email is herein expressly granted) to resolve the same. The \$790 fee for filing the Request for Continued Examination is submitted herewith. The Commissioner is hereby authorized to charge any additional amount or credit any over payment to Deposit Account No. 21-0765 referencing Attorney Docket No. 2360/SPRI.105623.

Respectfully submitted,

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